

**REMARKS**

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 00403143.1 dated November 10, 2000, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on November 9, 2001, thereby confirming that the listed references have been considered.

Claims 1-21 have been examined on their merits.

Applicants herein cancel claims 2, 4, 13 and 15 without prejudice and/or disclaimer.

Applicants herein amend claims 1 and 12 to recite the switching device arrangement and their coupling to the active and spare terminating boards.

Applicants herein editorially amend claims 3, 9-11, 14 and 16-21 to correct awkward or grammatically incorrect language, to remove reference callouts and to conform the claims to U.S. practice. The amendments to claims 3, 9-11, 14 and 16-21 were not made for reasons of patentability.

Claims 1, 3, 5-12, 14 and 16-21 are all the claims presently pending in the application.

1. Claims 1 and 12 stand objected to as containing informalities, specifically the word "criterium." Applicants have amended claims 1 and 12 to remove the objected-to word, and submit that the objection has been overcome. Applicants request withdrawal of the objection to claims 1 and 12.

2. Claims 1, 6-12 and 16-21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ishibashi *et al.* (U.S. Patent No. 5,663,949). Applicants traverse the § 102(b) rejection of claims 1, 6-12 and 16-21 for at least the reasons discussed below.

As acknowledged by the Patent Office, independent claims 1 and 12 fail to teach or suggest at least  $2 \times 2$  switching devices that are coupled to active terminating boards, spare terminating boards and to each other as recited in claims 1 and 12, respectively. Based on at least the foregoing reason, Applicants submit that claims 1 and 12 are allowable over Ishibashi *et al.*, and further submit that claims 6-11 and 16-21 are allowable as well, at least by virtue of their dependency from claims 1 and 12, respectively. Applicants respectfully request that the Patent Office reconsider and withdraw the § 102(b) rejection of claims 1, 6-12 and 16-21.

3. Claims 2, 5 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ishibashi *et al.* in view of Chang *et al.* The rejection of claims 2 and 13 is now moot due to their cancellation. Applicants traverse the rejection of claim 5 for at least the following reasons.

Claim 5 depends from claim 1. The Patent Office cites Chang *et al.* for its disclosure of a protection switching system that uses optical switches. Chang *et al.*, however, does not cure the deficient teachings of Ishibashi *et al.* with respect to claim 1, namely that Ishibashi *et al.* fail to teach or suggest at least  $2 \times 2$  switching devices that are coupled to active terminating boards, spare terminating boards and to each other as recited in claim 1. Thus, Applicants submit that

claim 5 is patentable at least by virtue of its dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 5.

4. Claims 3, 4, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ishibashi *et al.* in view of Eguchi *et al.* (U.S. Patent No. 5,737,388). The rejection of claims 4 and 15 is now moot due to their cancellation. Applicants respectfully traverse the § 103(a) rejection of claims 3 and 14 for at least the reasons discussed below.

The Patent Office acknowledges that Ishibashi *et al.* fail to teach or suggest the coupling of switching devices to each other and to fiber interface cards, and more specifically, that Ishibashi *et al.* fails to teach or suggest the specific connection relationships between switching devices and terminating cards as recited in claim 4. Applicants have incorporated the recitations of cancelled claim 4 into claim 1. In addition, Applicants note that the Patent Office has not cited Eguchi *et al.* as providing any teaching or suggestion of the specific connection relationships between switching devices and terminating cards as recited in claim 1.

The Patent Office appears to assert that it would have been obvious to modify Ishibashi *et al.* to come up with the features of the invention recited in claim 1. See April 15, 2005 Office Action, page 9, asserting that “it would have been obvious to one of ordinary skill in the art ... to couple the switches with the terminals as claimed....” The mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modifications. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). None of the prior art references cited in the April 15, 2005 Office Action teach or suggest

the disclose or suggest the specific connection relationships between switching devices and terminating cards as recited in claim 1.

Moreover, the characterization of certain claim recitations as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Patent Office to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *In re Lahu*, 747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984). Furthermore, an Patent Office may not rely on official notice, or judicial notice, or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). Here, one of the points of novelty is the specific connection relationships between switching devices and terminating cards as recited in claim 1. The Patent Office has not cited, nor have the Applicants identified, any prior art which suggests or teaches this, or any other novel aspects of the present invention found in claim 1, and incorporated via dependency in claim 3. Thus, Applicants submit that the all limitations and motivation prongs of a *prima facie* case of obviousness have not been met by the combination of Ishibashi *et al.* and Eguchi *et al.* Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 3.

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With respect to claim 14, Applicants submit that claim 14 is allowable for at least reasons analogous to those for claim 3, in that claim 14 depends from claim 12, which has recitations similar to those of claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 14.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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**23373**

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